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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/940,815 | 09/30/1997 | CHRISTOPHER J. STEVENS | PM-421 | 5323 |
| 4743 | 7590 | 07/10/2006 | EXAMINER | |
| MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606 | | | MAYES, MELVIN C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1734 | |

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 08/940,815 | STEVENS, CHRISTOPHER J. | |
| | Examiner | Art Unit | |
| | Melvin Curtis Mayes | 1734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 April 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4 and 15-19 is/are allowed.
- 6) Claim(s) 1,5-14 and 21-25 is/are rejected.
- 7) Claim(s) 2 and 3 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/10/06.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

(1)

The indicated allowability of claim 8 is withdrawn.

Claim Rejections - 35 USC § 112

(2)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(3)

Claims 22-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the guide means including first, second and third posts, does not reasonably provide enablement for guide means including only a first post and a second post. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

According to the specification, the guiding means include a tape positioning means provided by posts 7, 8, 9 which define a first slot for tape coming from the supply spool and second slot for passing the tape away from the tip towards the take-up spool. There is only support for three posts, not for only a first and second post as encompassed by Claim 22.

(4)

Claim 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the tip having guide wings, does not reasonably provide enablement for the guide means comprising guide wings extending from the tip. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

According to the specification, the tip has tape retaining means provided by a pair of wings projections. The guide means for twisting the tape are set forth as different from the tape retaining means.

(5)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(6)

Claims 8, 11, 12 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 11 claims “axis (axes) substantially perpendicular to a plane containing the tip edge and **parallel to the feed direction.**” Is the axis (axes) parallel to the feed direction or is the plane parallel to the feed direction?. Based on the figures, it appears that the claim is referring to a plane which contains the tip edge as being parallel to the feed direction, not to the axis (axes) being parallel to the feed direction. This should be made clear.

Claim 12 recites the limitation "the tip edge direction." There is insufficient antecedent basis for this limitation in the claim. There is no tip edge direction described in Claim 1.

Claim 25 claims guide wings positioned at the distal end of the tip. The figures show wing projections on the tip, however it is not clear from the specification and figures what is intended to be encompassed by the "distal end" of the tip.

Claim Rejections - 35 USC § 102

(7)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(8)

Claim 8 is rejected under 35 U.S.C. 102(a) as being anticipated by WO 93/04875.

WO 93/04875 (published 3/18/1993) discloses a coating film transfer tool comprising: coating film transfer tape 38; pay-out cylinder and winding cylinder 48; head 38 having peak-shaped portion 51 (tip having an edge); guide pin 57 for twisting the tape 90° toward the head; and guide pin 58 for twisting the tape before it is wound by the winding cylinder (Fig. 3 as described in related US Patent 5,379,477). As shown in Figure 3, the peak-shaped portion (edge) is inclined to the feed direction of the tape leaving the pay-out cylinder (supply spool), the path of the tape around the peak-shaped portion is perpendicular to the portion and inclined to the feed direction and the guide pin defines an arcuate surface contacted by the tape, the arcuate

surface having an axis perpendicular to a plane which contains the peak-shaped portion and which is parallel to the feed direction.

The present application only has support for the claimed guide element with arcuate surface contacted by the tape and for twisting the tape in foreign priority document GB 9310715 filed May 25, 1993 (guide pegs 22, 23). The embodiment of Claim 8 is not supported in foreign priority document GB 9302589 filed February 10, 1993.

(See also WO 93/02870 published 2/18/1993 which discloses coating film transfer tool with guide pins 25, 27 for twisting.)

Claim Rejections - 35 USC § 103

(9)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(10)

Claims 1, 5, 7, 11, 12 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 427 970 A1.

EP 0 427 870 A1 discloses a paint film transfer device comprising: picture revising tape 1 having white pressure sensitive transfer paint on a base material; feed reel 2 and takeup reel 7; pressure head 5 (tip having an edge); and guide rollers 11, 12 (guide means and tape positioning means) mounted in case 6, wherein the tape becomes twisted in its running paths from the feed reel to the pressure head and from the pressure head to the takeup reel (col. 11, line 40 – col. 12, line 42, Figs 1 and 2). As shown in Figure 1 and 2, the pressure head edge is at an angle to the

path of the tape from the feed reel and the path of the tape around the edge is perpendicular to the edge.

Further, by the tape being directed such that near the edge of the pressure head it is perpendicular to the edge of the pressure head as shown in Figure 1, the path of the tape around the edge between the guide rollers (guide means) is obviously in a plane substantially perpendicular to the edge and inclined to the feed direction, as claimed.

(11)

Claims 1, 5-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-56690 in view of FR2643351 Abstract.

JP 63-56690 discloses a correction tape dispenser comprising tape 11; supply spool 16 from which the tape is fed, take-up spool 17; tip 25 having edge around which the tape is fed; the tip having projections 23 and 24 (retaining means in the form of a pair of projections) adjacent the tip on each side the tip between which the tape is fed; arcuate surfaced members (posts or pegs) 18, 19 (guide means and tape positioning means) from which the tape passes to and from the tip; and an elongated case 12 enclosing the spools. As shown, the tip edge direction and the feed direction of the tape from the supply spool are at an angle of about 45° (Fig 1-3). JP 63-56690 disclose providing the tip 25 with guide channels 23a and 24a (retaining means as projections) on either side of the edge but do not disclose providing the tip such that the members 18, 19 operate in conjunction with the shape of the tip to twist the tape so that path of the tape around the edge is in a plane substantially perpendicular to the edge and inclined to the feed direction from the supply reel.

FR '351 Abstract teaches that a dispenser for tape such as white strips intended to mask other passages (correction tape) is made ergonomic so that the dispenser can be handled in the same way as a marker by providing the applicator axis perpendicular to the axis of the reel of tape so that the dispenser can be held like a marker. The tape undergoes a twist of 90° from the reel to the applicator.

It would have been obvious to one of ordinary skill in the art to have modified the correction tape dispenser of JP '690 by providing the tip perpendicular to the axis of the supply and take-up spools so that the tape undergoes twist of 90° from the spool to the tip edge, as taught by FR '351 Abstract, to make the dispenser more ergonomic so that it can be held like a marker. By providing the tip and its adjacent guide channels perpendicular to the axis of the supply spool to make the dispenser more ergonomic, the arcuate surfaced members from which the tape passes to and from the tip would obviously act as guide means or elements on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge is substantially perpendicular to the edge and inclined to the feed direction of the tape leaving the supply spool, as claimed, each arcuate shaped member having an axis perpendicular to a plane containing the tip edge, the plane parallel to the feed direction, as claimed in Claim 8.

At the edge of the tip, the path of the tape around the edge would be in a plane which is substantially perpendicular to the edge and which is inclined to the feed direction, as claimed.

(12)

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-56690 in view of FR2643351 Abstract as applied to claim 1, and further in view of DE 41 01 293.

DE '293 teaches that the tip 72 of an applicator for transferring correcting film is provided with shape which widens toward the edge around which the film passes (Fig. 5a).

It would have been obvious to one of ordinary skill in the art to have modified the correction tape dispenser of the reference as combined by providing the tip with a widening shape toward its edge, as taught by DE '293, as the shape of the applicator for transferring correcting film. Providing the tip with "extension portions" as claimed would have been obvious to one of ordinary skill in the art because DE '293 teaches that it is known in the art of correcting film dispensers to provide the tip around which the film passes with a shape which widens toward the edge.

Allowable Subject Matter

(13)

Claims 4 and 15-19 are allowed.

(14)

Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(15)

The following claim language drafted by the examiner and considered to distinguish patentably over the art of record in this application and overcome the rejection under 35 U.S.C. 112, first paragraph, is presented to applicant for consideration:

Claim 22, lines 11-13 amended to read “wherein the guide means include a first post, second post and a third post, wherein the tape extends between the second and third posts between the supply spool and the edge of the tip, and the tape extends between the first and second posts between the edge of the tip and the take-up spool.”

Description for three posts is found at col. 3, lines 25-36.

Response to Amendment

(16)

The Declaration under 37 CFR 1.132 filed April 10, 2006 is insufficient to overcome the rejection of claim 1 based upon JP 63-56690 as set forth in the last Office action because:

The assertion that the correction tape dispenser of Omori (JP 63-56690) would not work if the tip were rotated is mere conjecture based on the drawings of Omori and does not take into account the suggestion of FR 2643351 and the skill of one of ordinary skill in the art to make modifications to the tip of Omori to accommodate twisting of the tape from the peg to the tip (see also EP 0 427 870 A1 in which there is twist of the tape yet the tape is applied by a tip).

Response to Arguments

(17)

Applicant's arguments filed April 10, 2006 have been fully considered but they are not persuasive.

Applicant argues that rotating the applicator tip of Omori would destroy the functionality of the dispenser. Applicant argues that the posts 18, 19 of Omori deliver the tape to the head at an angle of approximately 45°.

(18)

The Examiner is not convinced that functionality of the dispenser would be destroyed by modifying based on the suggestion of de Ruyter. Based on the suggestion of de Ruyter, one of ordinary skill in the art would have known how to make any required modification to the tip of Omori to accommodate twisting of the tape from the peg to the tip (see also EP 0 427 870 A1 in which there is twist of the tape yet the tape is applied by a tip).

With respect to the delivery of the tape to the head, Claim 1 only claims that the path "around the edge" between the guide means is in a plane substantially perpendicular to the edge. Around the edge of the tip of Omori the path of the tape is perpendicular to the edge. Applicant is not claiming that the entire path of the tape from the guide means to the edge is perpendicular to the edge, only that the path of the tape around the edge is perpendicular (see also the rejection based on EP 0 427 870 A1).

Conclusion

(19)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
June 30, 2006